

REMARKS

Objections To The Drawings Under 37 CFR 1.84

Figs. 1A, 1B and 1C are objected to as failing to comply with 37 CFR 1.84 (5) and (4). The specification has been amended so that the reference numerals referenced in the detailed description conform with those of the figures. Also, a replacement drawing sheet is submitted for FIG.'s 1B and 1C to clearly indicate structures 30 and 40, respectively. Withdrawal of the objections to the drawings is thus respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 15, 31 and 32 are rejected under 35 U.S.C. §102(e) as being anticipated by *Helstab, et al.* (U.S. 6,073,031). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102 (e).

In particular, amended claim 1 now states:

1. (Currently amended) A docking station for a wireless communication device, the docking station comprising:
 - a support structure;
 - a cradle situated in the support structure to receive the wireless communication device;
 - a display situated in the support structure to display information received by the docking station from the wireless communications device; and
 - an energy source internal to the docking station which supplies energy to the wireless communication device when the wireless communication device is received in the cradle.

Amended claim 2 states:

2. (Currently amended) A docking station for a wireless communication device, the docking station comprising:
- a docking housing;
 - a display device, situated in the docking housing, that displays information received from the wireless communication device;
 - a cradle, disposed on the docking housing, that receives the wireless communication device;
 - a connector, situated in the cradle, that electrically couples the docking station to the wireless communication device;
 - an internal voltage source situated in the docking housing;
 - a charging circuit, situated in the docking housing, for charging a voltage source;
 - and
 - a switch for selectively coupling the charging circuit to the internal voltage source.

Amended claim 31 states:

31. (Currently amended) A method for using a wireless communication device, the method comprising:
- mounting the wireless communications device on a docking station that comprises:
 - (g) a cradle for the wireless communications device,
 - (h) a display device that displays information received from the wireless communication device,
 - (i) a connector for effecting an electrical interface to the wireless

communication device,

(j) a station power source,

(k) a charging circuit, and

(l) a switch operable in response to information indicating whether or

not a wireless communications device is docked at the docking station;

causing the station power source to be coupled to the wireless communications device; and

causing, in response to information that the wireless communication device is docked at the station, the charging circuit to charge the wireless communications device.

As the PTO provides in MPEP §2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, to sustain this rejection, the *Helstab, et al.* patent must contain all of the claimed elements of amended claims 1, 2, and 31 including a display device, that displays information (e.g., video signal) received from a mobile telephone or a wireless communication device. The *Helstab, et al.* patent teaches a liquid crystal display ("LCD") that is included in a base unit. In sharp contrast to the display device recited in amended claims 1, 2, and 31, the LCD of the *Helstab, et al.* does not display information received from a mobile telephone or a wireless communication device. As stated in column 5, lines 43 and 44 of the *Helstab, et al.* patent, the LCD is merely a part of a user interface for the base unit, and does not display information received from a mobile telephone or a wireless communication device. Therefore, the rejection is unsupported in the art and should be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* as applied to Claim 4 above, and further in view of *Uchiyama* (U.S. Pat. Appln. 2002/0072390). Claims 7, 8, 10, 11 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* as applied to claims 4 and 15 above, and further in view of *Obata et al.* (U.S. 5,960,208). Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Obata et al.* as applied to claim 7 above, and further in view of *Uchiyama*. Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* as applied to claim 2 above, and further in view of *Freadman* (U.S. 6,546,262). Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Freadman* as applied to claim 13 above, and further in view of *Obata et al.* Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Obata et al.* as applied to claim 16 above, and further in view of *Freadman*. Claims 18-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* in view of *Obata et al.* Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* in view of *Freadman*. Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Freadman* as applied to Claim 22 above, and further in view of *Obata et al.* Claims 24, 25 and 28-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Freadman* and further in view of *Obata et al.* Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Freadman* and further in view of *Obata et al.* as applied to Claim 25 above *Kobayashi*.

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Claims 5-14, 16, and 17 are dependent on amended claim 2 which is recited above. In addition, amended claim 18 states:

18. A docking station for a wireless communications device comprising:
- a display device that displays information received from the communications device; and
 - an apparatus that selectively supplies power to the communications device, the apparatus including:
 - a connector for electrically coupling the docking station to the communications device, the connector having at least first and second terminals;
 - a switch having a pole, a first terminal, and a second terminal, the switch operable in response to status information indicating whether a communications device is docked at the docking station;
 - a charging circuit coupled to the pole of the switch;
 - a station power source coupled to the first terminal of the switch; and
 - a detector that determines whether a communications device is docked at the station and provides status information as a result of the determination.

Amended claim 22 states:

22. A method of enhancing the capabilities of a wireless communications device for information handling, the method comprising:
- mounting the wireless communications device on a docking station that comprises:
 - (a) a cradle for the wireless communications device,
 - (b) a display device that displays information received from the wireless communications device,
 - (c) a connector for effecting an electrical interface to the wireless communication device,
 - (d) a station power source,

- (e) a charging circuit, and
- (f) a switch operable in response to information indicating whether or not a wireless communications device is docked at the docking station;
 - coupling a video output from the wireless communications device to the display device;
 - causing the station power source to be coupled to the wireless communications device; and
 - causing, in response to information that the wireless communication device is docked at the station, the charging circuit to charge the wireless communications device.

Amended claim 24 states:

24. An assembly for docking a wireless communication device (WCD) so as to enhance the capabilities of the device, the assembly comprising:
- a housing having a receptacle for the WCD;
 - a display device that displays information received from the WCD;
 - an internal chargeable power source;
 - a charging circuit;
 - a switching circuit, responsive to a predetermined status of the assembly, that selectively couples the charging circuit to the internal chargeable power source;
 - detachable means for coupling the charging circuit to a source of electrical power;
 - a video interface circuit for coupling the video output of the WCD to the display device;
 - a connector for electrically coupling the docking station to the WCD; and
 - a support for the housing.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, Applicant is under no obligation to submit evidence of nonobviousness.

Applicants submit that the Examiner cannot factually support a *prima facie* case of obviousness for the following, mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

35 U.S.C. § 103 states:

A patent may not be obtained... if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains... (emphasis added).

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Therefore, to sustain this rejection, the combinations suggested by the Examiner must contain all of the elements of the respective claims. By virtue of their dependence on independent claim 2, rejected claims 5-14, 16, and 17 include a display device that displays information received from a wireless communications device. Independent claims 18, 22 and 24 and their dependent claims also recite a display device that displays information received from a wireless communications device. In contrast, none of the combinations suggested by the Examiner includes such a display device in a docking station wherein the display device receives information from a wireless device that is docked with the docking station. As

discussed above, although, the *Helstab, et. al.* patent describes an LCD included in a base unit, the LCD is merely a part of a user interface for the base unit and does not display information received from a wireless communications device. Accordingly, for claims 5-14, 16, and 17 (which depend on independent claim 2) and for independent claims 18, 22, and 24 and their dependent claims, the combinations suggested by the Examiner do not teach at least one claimed element.

At least for the above reason mutually exclusive reason, the Examiner's burden of factually supporting *prima facie* case of obviousness is not met, and the rejections of dependent claims 5-14, 16, 17 which depend on claim 2, and independent claims 18, 22, and 24 and their dependent claims, under 35 U.S.C. § 103, should be withdrawn.

2. The combinations of references is improper.

A relevant portion of the MPEP § 2142 states:

...The Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

Here, the references cited by the Examiner fail to teach or even suggest the desirability of the combinations set forth in claims 5-14, 16, 17 which depend on independent claim 2, and independent claims 18, 22, 24 and the rejected claims dependent thereon, since none of the references teach all elements of the claims.

Thus, it is clear that none of the references provide any incentive or motivation supporting the desirability of the combination. Accordingly, there is no basis in the art for combining the references to support 35 U.S.C. § 103 rejections of claim 2's

dependent claims (namely claims 5-14, 16, 17) and claims 18, 22, and 24 and their dependent claims.

Also, the MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case, the combinations suggested by the Examiner result solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in any of the references from the suggested combinations as applied to claims 2, 18, 22, and 24. Therefore, at least for the above mutually exclusive reason, the rejections of claim 2's dependent claims (namely claims 5-14, 16, 17) and claims 18, 22, and 24 and their dependent claims, are unsupported in the art and should be withdrawn.

CONCLUSION

In view of the above, Applicants respectfully submit that amended claims 1, 2, 18, 22, 24, and 31 are in condition for allowance. Dependent claims 3-17, 19-21, 23,

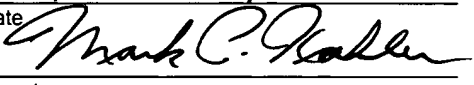
25-30, and 32 further limit the independent claims, and therefore, are also in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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